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10/812,791	03/30/2004	Francis G. McCabe	073338.0180 (04-50100 FLA	4222
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BAKER BOTTS L.L.P. 2001 ROSS AVENUE SUITE 600 DALLAS, TX 75201-2980			VETTER, DANIEL	
			ART UNIT	PAPER NUMBER
			3628	
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			08/06/2008	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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### Office Action Summary

**Application No.**

10/812,791

**Applicant(s)**

MCCABE ET AL.

**Examiner**

DANIEL P. VETTER

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**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,5-7,9,10,12-15,17,18,20-23,25 and 26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-7,9,10,12-15,17,18,20-23,25 and 26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Status of the Claims***

1. Claims 1-7, 9-15, 17-23, and 25-26 were previously pending in this application. Claims 1, 9, 12, 17, 20, and 25 were amended, and claims 3, 4, 11, and 19 were canceled in the reply filed May 5, 2008. Claims 1-2, 5-7, 9-10, 12-15, 17-18, 20-23, and 25-26 are currently pending in this application.

### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 5, 2008 has been entered.

### ***Response to Arguments***

3. Applicant's arguments with respect to the rejections made under § 103(a) have been fully considered but they are not persuasive. Applicant argues that the applied references are not sufficient to teach "receiving prioritization information associated with the services." Remarks, page 13. Examiner respectfully disagrees. One of the features of the system disclosed by DeLorme allows the user to prioritize different aspects of her search.

TRIPS operations can be repeated within, or varied among, these four main input menus at 155, 157, 161, and 163—as described hereinafter with reference to FIG. 4 in particular. Additionally or alternatively, TRIPS users can customize or individualize their travel planning sessions by engaging varied sequences of HOW?, WHAT/WHO?, WHERE? and WHEN? queries, or equivalent input genres. Thus, two TRIPS users—each with individual travel preferences, problems and agendas—could engage in different sequences of TRIPS main input menu operations e.g. as follows: (1) WHERE?, WHEN?, WHAT/WHO?, HOW?; or (2) WHAT/WHO?, WHEN?, WHEN?, WHEN?, HOW?, WHAT/WHO?, WHERE?, WHERE?, WHEN?, HOW?. A great many other sequences are feasible, varying in the number and order of operations, as well as the selection among the various main input menus, related GUIs or sub-menus. User selectivity within TRIPS and the opportunities for individualized or personalized output from TRIPS are further

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enhanced by variable TRIPS travel inquiry parameters, output/format/detail controls and travel information previews, manual versus automated sequencing options, as well as user-controlled integration capabilities among component steps or sub-sessions in a TRIPS travel planning session and between TRIPS Subsystems, as detailed hereinafter.

DeLorme, col. 27, lines 14-38. In other words, users are able to enter their prioritization information by the order of their sessions, sub-sessions, and follow-up sessions while navigating through the service menus. For example, a user valuing proximity over all other criteria would begin the search in the WHERE? menu, thereby prioritizing location over subsequent narrowing factors used in the navigation. The broad terms used in the claims do not exclude such an embodiment that reads on this feature of DeLorme. Accordingly, the rejections made under § 103(a) are maintained.

#### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-2, 5-7, and 26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

6. Claims 1-2, 5-7, and 26 are directed to a series of steps. In order for a series of steps to be considered a proper process under § 101, a claimed process should either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). Thus, to qualify as patent eligible, these processes must positively recite the other statutory class to which it is tied (e.g., by identifying the apparatus that accomplishes the method steps), or positively recite the subject matter that is being transformed (e.g., by identifying the product or material that is changed to a different state). The claims do not recite any computerized or mechanical apparatus used to perform the process. And while the claimed invention determines certain itineraries and services, they are never actually implemented to affect a physical result

or transformation. As such, the claims concretely identify neither the apparatus performing the recited steps nor any transformation of underlying materials, and accordingly are directed to non-statutory subject matter.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 17, 18, and 20-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
9. Claims 17, 18, and 20-23 are directed to "logic for building an itinerary, the logic embodied in a tangible computer-readable medium and operable to" perform the recited steps. However, it is unclear how "logic" is "operable to" perform steps. Even if it is functional/executable to cause a computer to perform certain steps, the "logic" itself would not perform the recited identifying services and other steps, rather a computerized system on which the logic is stored performs the steps. Moreover, the term "logic" reasonably encompasses the reasoning behind a software program, aside from the executable program itself (see e.g., Specification page 13, line 12, referring to Fig. 4 as a "logic diagram").

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-2, 5-7, 9-10, 12-15, 17-18, 20-23, and 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeLorme, et al., U.S. Pat. No. 5,948,040

(Reference A of the PTO-892 part of paper no. 20070823) in view of Swart, et al., U.S. Pat. Pub. No. 2002/0095319 (Reference B of the PTO-892 part of paper no. 20070823).

12. As per claim 1, DeLorme teaches a method for building an itinerary, comprising: receiving one or more consumer descriptors at a consumer agent operating on behalf of a consumer (col. 41, lines 45-46); identifying a plurality of recommended services from a plurality of services (col. 41, lines 49-50) using a service agent operating as a service finder (col. 10, lines 21-31), the recommended services identified in accordance with the one or more consumer descriptors (col. 19, lines 38-39; col. 41, lines 45-50), each service of the plurality of services associated with a service description (col. 56, line 35), the identifying the recommended services from the services using the service agent further comprising: receiving prioritization information associated with the services (col. 26, lines 30-31), the prioritization information comprising at least one of a compatibility metric, a proximity metric, and an evaluation metric for a service (col. 26, lines 59-67), the compatibility metric measuring compatibility of the service and the one or more consumer descriptors, the proximity metric measuring the distance between the service and a consumer location of the consumer, the evaluation metric measuring at least one of a popularity and a rating of the service (col. 26, lines 40-42, 65-67; col. 30, lines 28-31); prioritizing the services in accordance with the prioritization information (col. 26, lines 37-40, 59-64); and identifying the recommended services in accordance with the prioritization (col. 26, lines 42-44, 64-67); presenting a timeline and the recommended services (col. 22, lines 24-26; col. 41, line 57; Fig. 1B-2); identifying an advertisement in accordance with the one or more consumer descriptors using an advertising agent (col. 64, lines 5-10, 20-21); presenting the advertisement (col. 61, lines 49-50, 54-55); determining a selection of a service offering of the recommended services as an event for the itinerary (col. 19, lines 35-39; col. 41, lines 49-51); indicating one or more available times of the selected service offering (col. 19, lines 44-45; col. 41, lines 52-53); and determining a selection of an available time of the one or more available times of the selected service offering (col. 19, lines 49-50; col. 41, line 57). While DeLorme

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broadly teaches the selection of services and times (e.g., col. 19, lines 35-50; col. 41, lines 45-58) and also the use of timelines for scheduling (col. 22, lines 24-26; Fig. 1B-2), it does not explicitly teach that these selections are made using the timeline; which is taught by Swart (¶¶ 0107, 0110; Fig. 4a). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the above teachings of Swart into the DeLorme because it allows managing and creating time-based entities in a transaction database that greatly reduces the need for management (as taught by Swart; ¶ 0024).

13. As per claim 9, DeLorme teaches a system for building an itinerary, comprising: a database embodied in a tangible computer-readable medium, the database operable to store one or more consumer descriptors associated with a consumer (col. 19, lines 26-29); and one or more agents embodied in a tangible computer-readable medium, the one or more agents coupled to the database and operable to (col. 13, lines 54-55): identify a plurality of recommended services from a plurality of services (col. 41, lines 49-50) using a service agent operating as a service finder (col. 10, lines 21-31), the recommended services identified in accordance with the one or more consumer descriptors (col. 19, lines 38-39; col. 41, lines 45-50), each service of the plurality of services associated with a service description (col. 56, line 35), the identifying the recommended services from the services using the service agent by: receiving prioritization information associated with the services (col. 26, lines 30-31), the prioritization information comprising at least one of a compatibility metric, a proximity metric, and an evaluation metric for a service (col. 26, lines 59-67), the compatibility metric measuring compatibility of the service and the one or more consumer descriptors, the proximity metric measuring the distance between the service and a consumer location of the consumer, the evaluation metric measuring at least one of a popularity and a rating of the service (col. 26, lines 40-42, 65-67; col. 30, lines 28-31); prioritizing the services in accordance with the prioritization information (col. 26, lines 37-40, 59-64); and identifying the recommended services in accordance with the

prioritization (col. 26, lines 42-44, 64-67); present a timeline and the recommended services (col. 22, lines 24-26; col. 41, line 57; Fig. 1B-2); identify an advertisement in accordance with the one or more consumer descriptors using an advertising agent (col. 64, lines 5-10, 20-21); present the advertisement (col. 61, lines 49-50, 54-55); determine a selection of a service offering of the recommended services as an event for the itinerary (col. 19, lines 35-39; col. 41, lines 49-51); indicate one or more available times of the selected service offering (col. 19, lines 44-45; col. 41, lines 52-53); and determine a selection of an available time of the one or more available times of the selected service offering (col. 19, lines 49-50; col. 41, line 57). While DeLorme broadly teaches the selection of services and times (e.g., col. 19, lines 35-50; col. 41, lines 45-58) and also the use of timelines for scheduling (col. 22, lines 24-26; Fig. 1B-2), it does not explicitly teach that these selections are made using the timeline; which is taught by Swart (¶¶ 0107, 0110; Fig. 4a). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the above teachings of Swart into the DeLorme because it allows managing and creating time-based entities in a transaction database that greatly reduces the need for management (as taught by Swart; ¶ 0024).

14. As per claim 17, DeLorme teaches logic for building an itinerary, the logic embodied in a tangible computer-readable medium and operable to: receive one or more consumer descriptors at a consumer agent operating on behalf of a consumer (col. 41, lines 45-46); identify a plurality of recommended services from a plurality of services (col. 41, lines 49-50) using a service agent operating as a service finder (col. 10, lines 21-31), the recommended services identified in accordance with the one or more consumer descriptors (col. 19, lines 38-39; col. 41, lines 45-50), each service of the plurality of services associated with a service description (col. 56, line 35), the identifying the recommended services from the services using the service agent by: receiving prioritization information associated with the services (col. 26, lines 30-31), the prioritization information comprising at least one of a compatibility metric, a proximity



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metric, and an evaluation metric for a service (col. 26, lines 59-67), the compatibility metric measuring compatibility of the service and the one or more consumer descriptors, the proximity metric measuring the distance between the service and a consumer location of the consumer, the evaluation metric measuring at least one of a popularity and a rating of the service (col. 26, lines 40-42, 65-67; col. 30, lines 28-31); prioritizing the services in accordance with the prioritization information (col. 26, lines 37-40, 59-64); and identifying the recommended services in accordance with the prioritization (col. 26, lines 42-44, 64-67); present a timeline and the recommended services (col. 22, lines 24-26; col. 41, line 57; Fig. 1B-2); identify an advertisement in accordance with the one or more consumer descriptors using an advertising agent (col. 64, lines 5-10, 20-21); present the advertisement (col. 61, lines 49-50, 54-55); determine a selection of a service offering of the recommended services as an event for the itinerary (col. 19, lines 35-39; col. 41, lines 49-51); indicate one or more available times of the selected service offering (col. 19, lines 44-45; col. 41, lines 52-53); and determine a selection of an available time of the one or more available times of the selected service offering (col. 19, lines 49-50; col. 41, line 57). While DeLorme broadly teaches the selection of services and times (e.g., col. 19, lines 35-50; col. 41, lines 45-58) and also the use of timelines for scheduling (col. 22, lines 24-26; Fig. 1B-2), it does not explicitly teach that these selections are made using the timeline; which is taught by Swart (¶¶ 0107, 0110; Fig. 4a). It would have been *prima facie* obvious to one having ordinary skill in the art at the time of invention to incorporate the above teachings of Swart into the DeLorme because it allows managing and creating time-based entities in a transaction database that greatly reduces the need for management (as taught by Swart; ¶ 0024).

15. As per claims 2, 10, and 18, DeLorme in view of Swart teaches the method of claim 1 system of claim 9 and logic of claim 17 as described above. DeLorme further teaches comparing the service descriptions with the one or more consumer descriptors

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comprising a consumer requirement (col. 56, lines 33-36); and identifying the recommended services in accordance with the comparison (col. 56, lines 33-36).

16. As per claims 12 and 20, DeLorme in view of Swart teaches the system of claim 9 and logic of claim 17 as described above. DeLorme further teaches the prioritizing the services in accordance with the prioritization information further comprises: if the prioritization information comprises a compatibility metric and a proximity metric, the compatibility metric being weighted higher than the proximity metric (col. 26, lines 41-42); if the prioritization information comprises a proximity metric and an evaluation metric, the proximity metric being weighted higher than the evaluation metric (col. 26, lines 64-66). Examiner notes that the above weighting schemes are all least suggested by DeLorme if not explicitly related individually, because the reference teaches that evaluation is a parameter that is weighted in accordance with other preferences (col. 47, lines 40-41) and that the system is capable of weighting preferences in any desirable order in relation to one another by routine engineering and with predictable results (col. 23, lines 38-39; col. 26, lines 14-28).

17. As per claims 5, 13, and 21, DeLorme in view of Swart teaches the method of claim 1 system of claim 9 and logic of claim 17 as described above. DeLorme further teaches indicating an offered timeframe during which the selected service offering is offered (col. 19, lines 37-41, 49-50; col. 41, line 51); receiving a selection of the selected service offering within the offered timeframe (col. 19, lines 35-37); and indicating the one or more available times of the selected service offering within the offered timeframe (col. 19, lines 43-45, 49-50; col. 41, lines 52-57).

18. As per claims 6, 14, and 22, DeLorme in view of Swart teaches the method of claim 1 system of claim 9 and logic of claim 17 as described above. DeLorme further teaches detecting that the service offering has been placed in the timeline (col. 21, lines 8-12).

19. As per claims 7, 15, and 23, DeLorme in view of Swart teaches the method of claim 1 system of claim 9 and logic of claim 17 as described above. DeLorme further

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teaches detecting that the service offering has been placed at a time corresponding to the available time (col. 21, lines 8-12).

20. As per claims 8, 16, and 24, DeLorme in view of Swart teaches the method of claim 1 system of claim 9 and logic of claim 17 as described above. DeLorme further teaches the timeline comprises a fuzzy timeline undivided by a plurality of fixed time segments (col. 41, lines 24-25).

21. As per claim 25, DeLorme teaches a system for building an itinerary, comprising: means for receiving one or more consumer descriptors at a consumer agent operating on behalf of a consumer (col. 41, lines 45-46); means for receiving prioritization information associated with the services (col. 26, lines 59-64); means for prioritizing the services in accordance with the prioritization information (col. 26, lines 64-67); means for identifying the recommended services in accordance with the prioritization (col. 26, lines 64-67); means for identifying a plurality of recommended services from a plurality of services (col. 41, lines 49-50) using a service agent operating as a service finder (col. 10, lines 21-31), the recommended services identified in accordance with the one or more consumer descriptors (col. 19, lines 38-39; col. 41, lines 45-50), each service of the plurality of services associated with a service description (col. 56, line 35); means for presenting a timeline and the recommended services (col. 22, lines 24-26; col. 41, line 57; Fig. 1B-2); means for identifying an advertisement in accordance with the one or more consumer descriptors using an advertising agent (col. 64, lines 5-10, 20-21); means for presenting the advertisement (col. 61, lines 49-50, 54-55); means for determining a selection of a service offering of the recommended services as an event for the itinerary (col. 19, lines 35-39; col. 41, lines 49-51); means for indicating one or more available times of the selected service offering (col. 19, lines 44-45; col. 41, lines 52-53); and means for determining a selection of an available time of the one or more available times of the selected service offering (col. 19, lines 49-50; col. 41, line 57). While DeLorme broadly teaches the selection of services and times (e.g., col. 19, lines 35-50; col. 41, lines 45-58) and also the use of timelines for scheduling (col. 22, lines 24-26; Fig. 1B-2), it does not explicitly teach that these selections are made using the

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timeline; which is taught by Swart (¶¶ 0107, 0110; Fig. 4a). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the above teachings of Swart into the DeLorme because it allows managing and creating time-based entities in a transaction database that greatly reduces the need for management (as taught by Swart; ¶ 0024).

22. As per claim 26, DeLorme in view of Swart teaches the limitations of claims 1-8 as described above.

### ***Conclusion***

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL P. VETTER whose telephone number is (571)270-1366. The examiner can normally be reached on Monday through Thursday from 8am to 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JOHN W HAYES/

Supervisory Patent Examiner, Art Unit 3628

